



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/577,213 | 04/25/2006 | Thomas Dinger | 10191/4115 | 3340 |

| | | |
|---|------|------------|
| 26646 | 7590 | 08/22/2007 |
| KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004 | | |

| | |
|--------------------|--|
| EXAMINER | |
| MCCALL, ERIC SCOTT | |

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
| 2855 | |

| | |
|------------|---------------|
| MAIL DATE | DELIVERY MODE |
| 08/22/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/577,213

Applicant(s)

DINGLER ET AL.

Examiner

Eric S. McCall

Art Unit

2855

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 12 and 15-22 is/are rejected.
- 7) ☒ Claim(s) 13 and 14 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 April 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

**METHOD FOR OPERATING AN INTERNAL
COMBUSTION ENGINE**

FIRST OFFICE ACTION

TITLE

The title is objected to because the title is not descriptive of the claimed invention. A new title is required that is clearly indicative of the invention to which the claims are directed.

INFORMATION DISCLOSURE STATEMENT

The listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with 37 CFR 1.98. 37 CFR 1.98(a)(2) requires a legible copy of: (1) each foreign patent; (2) each publication or that portion which caused it to be listed; (3) for each cited pending U.S. application, the application specification including claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion, unless the cited pending U.S. application is stored

Art Unit: 2855

in the Image File Wrapper (IFW) system; and (4) all other information, or that portion which caused it to be listed. In addition, each IDS must include a list of all patents, publications, applications, or other information submitted for consideration by the Office (see 37 CFR 1.98(a)(1) and (b)), and MPEP § 609.04(a), subsection I. states, "the list ... must be submitted on a separate paper." Therefore, the references cited in the Search Report have not been considered. The Applicant is advised that the date of submission of any item of information or any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the IDS, including all "statement" requirements of 37 CFR 1.97(e). See MPEP § 609.05(a).

The information disclosure statement filed on April 25, 2006 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

The Examiner points out that no copies of the Foreign Patent Documents referenced on the said information disclosure statement are within the file (and thus have not been provided by the Applicant or the International Searching Authority).

CLAIMS

35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12, 18, 21, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Rich (6,321,593).

With respect to claim 12, Rich sets forth a method for operating an internal combustion engine having a fuel-driven combustion motor, in which fuel is delivered under pressure to the combustion motor via a fuel delivery system, the method comprising:

determining a pressure decay rate in the fuel delivery system (col. 1, lines 59/60); and
inferring a fault as a function of a comparison of the pressure decay rate with a predefined threshold value (col. 1, lines 61/62).

With respect to claim 18, Rich sets forth the recognition of a fault in the fuel supply system when the pressure decay rate is less than a predetermined rate (col. 1, lines 61/62) and

Art Unit: 2855

thus the suggestion that a fault is recognized when an absolute value of the pressure decay rate falls below the predefined threshold value as claimed.

With respect to claim 21, the operation of a fuel delivery system dictates the separation of a high-pressure circuit from a low-pressure circuit. The determination of the pressure decay in the Rich teaching occurs in the high-pressure circuit.

35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rich (6,321,593).

With respect to claim 15, Rich fails to set forth recognizing a leak in the fuel delivery system in the event an absolute value of the pressure decay rate exceeds the predefined threshold value.

Art Unit: 2855

However, it would have been obvious to one having ordinary skill in the art to recognize a leak in the fuel delivery system in the event an absolute value of the pressure decay rate exceeds the predefined threshold value.

The motivation being that a predefined threshold value is set forth to establish proper engine operating conditions. If a measured value (ie. rate) does not agree with that threshold value, either being less than or greater than, one having ordinary skill in the art would have reason to believe that proper operating conditions are not obtained.

With respect to claims 16, 17, 19 and 20, Rich fails to set forth activating a limitation of a quantity of fuel delivered, which includes shutting off the engine and preventing a restart, when a fault in the fuel supply system has been recognized as claimed.

However, it would have been obvious to one having ordinary skill in the art armed with said teaching to limit a fuel supply or shut off the engine when a fault has been recognized.

The motivation being that when a fault in a fuel supply is recognized, one would have motivation to limit or stop the fuel supply until the fault has been fixed as a safety precaution and in order to minimize wasted fuel.

Art Unit: 2855

Allowable Subject Matter

Claims 13 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims because the prior art fails to teach or suggest the claimed subject matter of claim 13.

CITED DOCUMENTS

The Applicant's attention is directed to the enclosed "PTO-892" form for the prior art made of record at the time of this office action.

CONTACT INFORMATION

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Eric S. McCall whose telephone number is (571) 272-2183.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

Art Unit: 2855

applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eric S. McCall
Primary Examiner
Art Unit 2855
Aug. 09, 2007